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Inventor: Sheng-Bin

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REMARKS

Applicant appreciates the attention of the Examiner to the application. The Office Action of the Examiner of March 15, 2005 has been reviewed with care in the preparation of this response. The amendment above and the following remarks are believed to be fully responsive to this action.

Status of Claims

Claims 1-4, 6-8, and 10-22 are pending. The pending claims set forth a novel and non-obvious soft storage bin. Allowance of all pending claims is respectfully requested in view of the above amendment and the following remarks.

Claims 1-4, 6-8, and 10-22 were rejected as being unpatentable under 35 U.S.C. §103(a) over Bauernfreund et al (U.S. Patent No. 2,485,028) in view of Wang et al (U.S. Patent No. 6,149,025). Claims 1-4, 6-8, and 10-22 were also rejected as being unpatentable under 35 U.S.C. §103(a) over Bauernfreund in view of Wang and further in view of Nickell et al (U.S. Patent No. 6,244,443).

Applicant thanks the Examiner for the telephonic interview with counsel on May 26, 2005. A discussion was held during this interview regarding the present Office Action and possible amendment to certain of the pending claims, in particular to independent claim 1. In response to this discussion and the comments made by the Examiner, Applicant has prepared and hereby submits the above amendment to the claims.

Claims 1 and 19 have been amended. The proposed amendment is fully supported by the specification to the application and does not include any new matter. The pending claims as amended are not rendered unpatentable by the references cited but are instead patentably distinguishable over such prior art.

Applicant now turns to the particular points raised by the Examiner in the Office Action of March 15, 2005 as they pertain to pending claims 1-4, 6-8, and 10-22.

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Rejection of Claims 13-18 under 35 U.S.C. §103(a)

Claim 13-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bauernfreund in view of Wang and over Bauernfreund in view of Wang and further in view of Nickell. Claims 14-18 are dependent to independent claim 13.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Jones, 958 F.2d 347 (Fed. Cir. 1992). In particular, there must be more of a justification for combining references or modifying them than solely the fact that such pieces of prior art happened to have been known at the time of the invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. MPEP §2143.01.

The bin in claim 13 includes a body of flaccid material forming a closed bottom where the bottom is bound to each of the bin's four sidewalls along a bottom edge. The Examiner acknowledges that these features are missing from Bauernfreund and asserts that Wang teaches the absent limitations. Wang discloses, however, a box body 4 made from strong coarse cloth having four horizontal top rod members 1, two horizontal bottom rod members 2, and four vertical rod members 3. (Wang at col. 2, lines 1-28; FIG. 1).

Even if Wang could arguably be said to show the structure in question, the Examiner has failed also to have made the necessary showing of reasons or motivation within Bauernfreund and Wang that would support the combination and/or modification relied upon by him in rejecting claim 13 under §103(a). The Examiner makes reference in the Office Action to how it "would have been obvious to employ the closed bottom of Wang in the container of Bauernfreund et al to prevent the board 10 from falling out of the container and to provide a stronger container." This statement, however, is not the required showing of a motivation within the teachings of these references that one needs to have arrived at Applicant's claimed invention.

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A specific explanation as to how a skilled artisan can extrapolate the invention from either Bauernfreund and Wang must be set forth by the Examiner. MPEP §706.02(j).

The Examiner may not simply select from the prior art the separate components of the claimed invention through the use of the blueprint supplied by the Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). The act of identifying the various elements of the claimed invention in the prior art without there being any teaching, suggestion or motivation for their combination is not the legal test of obviousness. It is, after all, well recognized that most, if not all, inventions are no more than combinations of old elements in the prior art. Environmental Designs, Ltd. V. Union Oil Co., 713 F. 2d 693, 218 USPQ 865 (Fed. Cir. 1983); Richdel, Inc. V. Sunspool Corp., 714 F. 2d 1573, 219 USPQ 8 (Fed. Cir. 1983). "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' Sensonics, Inc. v. Aerosonic Corp., 81 F. 3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996)." In re Rouffet, 47 USPQ 2d at 1457 (Fed. Cir. 1998).

Bauernfreund specifically teaches against the modification suggested by the Examiner whereby the box body of Wang is substituted for its body member 16. This change would create a cosmetic box that is no longer able to collapse by means of sidewalls 20 folding along their transverse crease. It would also defeat one of the stated objects of the invention, namely to provide an entirely non-metallic utility box. (Bauernfreund at col. 1, lines 9-10; col. 2, lines 28-39).

Wang also teaches against the suggested combination since its collapsible storage box discloses only a device that can experience axial collapse, i.e. collapse from the top down, where all four sidewalls must fold inward. A modification or improvement of a cosmetic box that undergoes lateral collapse, i.e. collapse from only two sidewalls, is clearly not taught or

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suggested to one skilled in the art by a structure such as the box in Wang that performs a different folding operation. If a proposed combination changes the principle of operation of the prior art being modified, the teachings of the references are then not sufficient to render the claim *prima facie* obvious. MPEP §2143.01.

Nowhere in Bauernfreund is there a teaching or suggestion that modifying the ledge 28 so that it extends across the bottom of the body member is needed or desirable in any way. It is simply an exercise in hindsight for justification to piece together the various components of the claimed invention for the Examiner to call upon the supposed level of skill of one skilled in the art by asserting that the desired motivation comes from some need to make the bottom of the body member stronger to prevent the base member 10 from falling out. This need for a stronger bottom is neither expressed nor suggested in the reference. Without a showing of such a need, the proposed modification of the box in Bauernfreund by the Examiner is extraneous and highly unsatisfactory for the expressed purposes of the cosmetic case since the base member already serves as its bottom and the addition of more fabric material conflicts with the stated goal of keeping the device reduced in size for storage and traveling when it is collapsed. (Bauernfreund at col. 1, lines 1-4; col. 2, lines 45-53).

Applicant's bin in claim 13 also requires both second sidewalls of the body to be embedded with two hard half-wall boards that are separated by a folding-seam in the body. The box in Bauernfreund, on the other hand, teaches sidewalls 20 that are creased transversely near their center to define segments 22 and 24, not separate wall boards. (Bauernfreund at col. 2, lines 29-31). Since this transverse crease constitutes a fold point when the box is collapsed, a row of stitching is provided along the crease when the fabric cover is placed over all of the walls that is similar to, but distinct from, the stitching that serves as hinge connections at the junction points between the sidewalls. (Bauernfreund at col. 2, lines 32-39). These joined, albeit hinged, segments of sidewalls 20 in the reference can be contrasted with the plurality of separate elements or partitions 32 comprising the partition means of the utility box. These elements are specifically disclosed as being individually covered in fabric and provided with stitching between adjacent pieces to permit the partition means to be folded. (Bauernfreund at col. 2, line 54 - col.

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3, line 10; Figs. 4 and 7).

The Examiner states that while the specification in Bauernfreund may not teach two half-boards separated by a folding-seam, this feature is shown in Fig. 7 of the reference and that such "accidental disclosure" can be relied upon as a teaching of the applicable prior art. Applicant submits that Fig. 7 does not clearly show and is not intended to clearly show the claimed limitation as asserted by the Examiner. The drawing is present rather to attempt to depict the construction set forth in the specification of the reference.

Even if there would be some "accidental disclosure" achieved by Fig. 7, however, the legal authority cited by the Examiner in the Office Action in support of his reliance upon Bauernfreund is not pertinent to his taking such a position. None of the cases cited stand for the proposition that a teaching can be drawn from a drawing in a reference even when such supposed disclosure is in conflict with the specific assertions made regarding that drawing in the actual specification to the reference. The "accidental disclosure" addressed in these cases either deals with something shown in the drawings that is not essential to the invention claimed in the reference and therefore not commented upon in its specification (*In re Bager*, 18 C.C.P.A. (Patents) 1094, 47 F. 2d 951, 8 USPQ 484), deals with support in the specification for the disclosure in the drawing but that had not been referred to or relied upon by the Board of Appeals (*In re Wagner*, 20 C.C.P.A. (Patents) 985, 63 F. 2d 987, 17 USPQ 243), or deals with a drawing in a reference that is simply showing a particular embodiment not specifically described in its specification, the drawing also being just one of several references cited by the Patent Office as disclosing the structure in question (*In re Seid*, 34 C.C.P.A. (Patents) 1039, 73 USPQ 431).

This deficiency in the primary reference is not cured by Wang in that it fails to even disclose a sidewall having two embedded hard half-wall boards. Nor are these missing limitations shown by Nickell as asserted in the Office Action. A bulk bag 20 with eight identical sidewall portions 28-42 is taught in Nickell. Each of these sidewalls is defined by spaced apart vertical seams 72, 74 and provided with a single stiffening panel 80. (Nickell at col. 1, lines 21-29, 44-54; Fig. 6). Nickell does not disclose any sidewall portion having two half-wall boards, much less two sidewalls having such boards and having them separated by a folding-seam. Any

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folding of the side wall assembly 50 is between the sidewall portions comprising the octagonal side wall 22. Such folding along the vertical edges of the sidewalls is acknowledged by the Applicant as having already been disclosed between the sidewalls in Bauernfreund as previously stated. The references cited by the Examiner, therefore, do not teach or suggest all of the limitations set forth in independent claim 13.

Even if arguably Bauernfreund, Wang and Nickell did teach each of the elements in claim 13, there still must be more of a motivation for combining the references than that it "would have been obvious to employ the separate pockets of Nickell et al in the container of Bauernfreund et al to provide a more flexible joint to make the container easier to collapse." There are no reasons or teachings within any of the references to support this assertion by the Examiner. He is simply calling upon some supposed level of skill of one skilled in the art to provide the necessary motivation. This is, however, not the required showing under the MPEP but rather an exercise in hindsight frowned upon by the courts.

For all of these reasons, a prima facie case of obviousness has not been established by the Examiner to maintain a rejection of independent claim 13. Applicant believes that this rejection should therefore be withdrawn and that this claim and each of claims 14-18 that depend from it be allowed.

Rejection of Claims 1-4, 6-8, 10-12 and 19-22 under 35 U.S.C. §103(a)

Claims 1-4, 6-8, 10-12 and 19-22 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Bauernfreund in view of Wang and over Bauernfreund in view of Wang and further in view of Nickell. Claims 2-4, 6-8 and 10-12 are dependent to independent claim 1. Claims 20-22 are dependent to independent claim 19.

Independent claims 1 and 19, as amended, add the limitation that removal of the bottom board from the interior of the body of the storage bin enables the bin to be collapsed by folding each second sidewall into the interior along its folding-seam and folding over the closed bottom. This limitation is not taught by any of the references cited by the Examiner. Bauernfreund lacks a body forming a closed bottom to have that bottom fold over upon collapse of the box. Wang

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teaches a box that undergoes axial collapse wherein the bottom of the cloth body does not fold over. Nickell, as stated earlier, has no sidewall with two half-wall boards embedded within it, much less two such sidewalls that fold into the interior of the bulk bag along a folding-seam between the boards. This reference also does not teach a bottom board whose removal enables collapse of the device.

In addition, for each of the reasons set forth above with respect to the allowance of claim 13, none of the references cited by the Examiner teach or suggest a sidewall having two half-wall pockets formed from a vertical folding-seam, each pocket receiving one hard half-wall board, or two sidewalls that each have two half-wall boards separated by a vertical folding-seam embedded within it. As explained above, there is also an absence of any justification for the combining of these references so as to arrive at Applicant's claimed invention.

Claims 1 and 19 as amended therefore overcome their rejection under 35 U.S.C. §103(a) and Applicant respectfully requests that each of these claims, as well as the claims that depend from them, be allowed.

Conclusion

Applicant's invention, as set forth in the pending claims, represents a novel and highly desirable soft storage bin.

Applicant believes that claims 1-4, 6-8, and 10-22, as amended, include essential features not disclosed or suggested in the prior art. With admission of the proposed amendment, Applicant submits that all rejections in the Office Action have been traversed by amendment and argument, placing the application in condition for allowance. Applicant respectfully requests therefore that the amendment above be allowed and that these rejections be reconsidered and withdrawn by the Examiner.

Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned if such would be helpful in resolving any issue which might remain.

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Respectfully submitted,



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